

1 **(4) REMARKS**

2
3 RESPONSE TO REJECTION UNDER ACTION PARA. 1 and 2: SEC. 102

4
5 U.S. Patent 6,252,716 (Makino) is cited against:
6 independent claim 1, and depending claims 2-4,
7 independent claim 5 and dependent claim 6, and
8 independent claim 8 and dependent claim 9.

9
10 The Action at page 2 states: "In reference to claim 1, Makino discloses a similar computer
11 annotator system ..."

12
13 Makino's system is neither a "similar computer annotator system" nor otherwise the present
14 invention by Lemon. Makino's invention is designed to allow handwritten data to be used with
15 PREPRINTED, FORM-BASED DOCUMENTS associated with specific applications such as
16 inspecting equipment or grading exams. Such forms correspond to Makino's "mark sheet"
17 (Makino Figure 1, item 4). An example of such a mark sheet is the "inspection form" shown in
18 Makino's Figure 2B. As a result, Makino's system *requires* a PREDETERMINED SET OF
19 ACCEPTABLE RESPONSES for each area on the form or mark sheet (Makino, Column 3,
20 Lines 63-67).

21
22 Lemon's present invention is different from Makino because it does not require either a
23 predefined set of acceptable inputs nor the additional computational cost and inflexibility
24 associated with Makino's handwriting recognition. For example, Makino's Figure 2A shows that
25 the possible user responses for the "inspection form" are the four hand-drawn symbols: check
26 mark, circle, slash and cross. Operationally, this list of PREDEFINED SYMBOLS are declared
27 in Makino's "code conversion table" as shown in Makino's Figure 5. Makino's system requires
28 this conversion table must be PREDEFINED - that is, the legal values must be ENUMERATED
29 in the table PRIOR to using Makino's system. Internal knowledge of Makino's system would be
30 needed to define this information. As a result, Makino's conversion table would be defined by a
31 SYSTEM SPECIALIST rather than a USER.

1 The situation is EXACTLY the OPPOSITE for Lemon's invention. Proceeding contrary to the
2 wisdom of the prior art is "strong evidence" of non-obviousness. W.L. Gore & Assoc., Inc. V.
3 Garlock, 220 USPQ 303 (CA FC 1983). In Lemon's present invention, the USER, not the
4 SYSTEM SPECIALIST, may introduce ARBITRARY SYMBOLS (that is, markings which the
5 system has never seen previously) AT ANY TIME while the system is being used. This is
6 possible because Lemon's system does NOT need to recognize nor interpret these symbols.
7 These symbols serve only as a VISUAL CUE or MNEMONIC to the user. Lemon's system then
8 links the Cartesian (x-y) coordinates of any PLACE on the tablet upon which a mnemonic
9 symbol has been drawn with a data address (URL) to be indexed for later retrieval when the
10 user subsequently points to one of the marks. Makino's input marks CANNOT be defined
11 on-the-fly as with Lemon's system. Each piece of information (or more generally, any
12 RESOURCE) has an address known as a URI (Uniform Resource Identifier). The most
13 common form of a URI is the URL (Uniform Resource Locator) which is used to reference
14 Internet pages. Because Lemon's system does not require any CHARACTER RECOGNITION,
15 no additional computation is needed to analyze the handwritten marks as is the case with
16 Makino's system. This is an important distinction because being able to introduce arbitrary
17 marks without prior knowledge as mnemonic aids allows ephemeral data addresses (URLs) to
18 be indexed easily and efficiently by Lemon's system.

19
20 The Action continues at Page 2, about line 18: "Referring to claims 2 and 3, the tablet having at
21 least one predetermined first surface" There is a difference here too. Because Makino's
22 system is used for filling out form-based documents, the user must place their markings in the
23 proper areas on the form in order for the input to be received correctly. For example, in
24 Makino's Figure 2B, the four possible legal markings (check, circle, slash and cross) must be
25 placed within the sixteen small check boxes of the inspection form. Placing these marks
26 anywhere else on Makino's form will result in either LOST DATA or ERRONEOUS RESULTS.
27 Again, this shows a clearly contrary operational difference from Lemon's present invention.

28
29 The Action continues at Page 2, about line 22: "In reference to claim 4, the tablet is connected
30 to a computer-like apparatus for accessing said preselected data address ... where the data
31 address is selected from a group" Again, there is a clear distinction. First, as noted above,

1 the term "preselected" as used in Lemon's claim 4 simply means that a mnemonic marking was
2 made at some PRIOR TIME in the CURRENT SESSION in which the system was being used -
3 it does not mean "prior to using the system" as is the requirement with Makino's
4 PREDETERMINED INPUT VALUES.

5
6 At Page 3 of Office Action, starting at line 3, it states: "Claim 5 is rejected on the same grounds
7 used in the rejection of claims 1-3" Lemon's system operates differently from Makino's as
8 explained above.

9
10 At Page 3 of the Action, starting about line 5: "In reference to claim 6, Makino allows for the
11 method to accommodate for a plurality of computer-accessible sites. . . ." Despite the fact that
12 Makino may, *arguendo* in principle, predefine any part of the form for data input, those areas, as
13 well as the acceptable values that can be written in them, MUST all be PREDETERMINED
14 before the user can operate Makino's system. Lemon's system avoids such restrictions and
15 limitations.

16
17 At Page 3 of the Action, starting about line 9: "The limitation of claim 8 resemble those of
18 claims 1 and 5" Again there is a difference. A mnemonic helps a person to remember a
19 piece of information more easily. For example, the name "ROY G. BIV" is a common
20 mnemonic for remembering the order of the colors in the natural light spectrum. In general, the
21 more visual or personal the mnemonic, the easier it is to use. As a result, a mnemonic tends to
22 be specific to an individual. The more personal the association, the more likely it will be
23 remembered - for example, using the letters on a phone dial to convert the digits of a phone
24 number into an memorable word or phrase. Mnemonics are created by and for individual users.
25 Each user should be able to choose their own mnemonics. Makino's requirement for all values
26 to be PREDETERMINED violates this principle. For example, in Makino's Figure 2A, the choice
27 of a "circle" to denote "already adjusted or cleaned" is no more appropriate than some other
28 symbol. They are predefined and Makino's user has no option but to use them. Again, Lemon's
29 system avoids such restrictions.

1 At Page 3 of the Action, starting about line 14: "In reference to claim 9, in his invention, Makino
2 clearly predefines specific locations on said tablet with data indexing functions..." Makino's
3 system is actually different than this element of the present invention. As described above,
4 Makino's tablet locations are NOT chosen by the user but rather they would be established by
5 the SYSTEM SPECIALIST who developed the form-based application. The user of Makino's
6 system is forced to use exactly those locations and enter exactly the input values from the
7 PREDEFINED set of allowable responses. They cannot use markings that are meaningful to
8 them personally. At best, it would be very awkward, if not impossible, to use Makino's system
9 for the URL bookmarking application handled by Lemon's invention.

10
11 There is another difference between the inventions of Lemon and Makino: Makino associates
12 PREDEFINED MARKS with PREDEFINED REGIONS on the tablet while Lemon associates
13 ARBITRARY REGIONS on the tablet with ARBITRARY MARKS and these regions, in turn, are
14 associated with the desired URLs. In Lemon's invention, writing in a particular area gives that
15 area a SPECIAL MEANING. In Makino's form-based approach, each area on the form has a
16 predefined purpose which determines what the user may write in that location. This reversal of
17 emphasis on LOCATION (where one writes something) versus CONTENT (what one has
18 written) is a major conceptual difference between the systems of Makino and Lemon. Such a
19 concept would not necessarily be obvious, motivated nor suggested by Makino because Makino
20 was focused on combining standard character recognition with more traditional, form-based
21 processing.

22
23 Thus, in summary, Makino discloses only a handwriting recognition tablet for use with a
24 computer. It has no disclosure at all reflective of Internet access techniques. The "object of the
25 (Makino) present invention" is to computerize grading of examination answer sheets. Col. 1; ll.
26 36-50, and 2:24-29. In the present application, Claims 1 and 8 and has been amended,
27 clarifying the nature of the "preselected data address" as such an Internet site. A dependent
28 claim - here claims 2-4, 6, 9 - includes all the limitations of the claim from which it depends and,
29 as such, makes specific that which was general. 35 USC 112; 37 C.F.R. Sec. 1.75c); Allen
30 Group, Inc. V. Nu-Star, Inc., 197 USPQ 849 (7th Cir. 1978); Ex parte Hansen, 99 USPQ 319
31 (Pat. Off. Bd. App. 1953). Dependent claims are non-obvious if the independent claims from

1 which they depend are non-obvious. In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); see
2 also Hartness International, Inc. V. Simplimatic Engineering Co., 2 USPQ2d 1826, 1831 (Fed.
3 Cir. (1987) to the same effect re novelty). Thus, allowance of a base claim as patentable
4 normally results in allowance of a claim dependent upon that claim.

5
6 Claim 5 as originally filed relates to "computer-accessible sites," and in context it is clear that
7 again Internet sites are defined. It is axiomatic that claims are not to be interpreted in a
8 vacuum. Slimfold Mfg. Col v. Kinlead Indus., 810 f.2d 1113, 1 USPQ 2d 1563 (Fed. Cir. 1987);
9 Moleculon Res. Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986). The claim
10 and specification language must be considered. DML, Inc. v. Deere & Co., 755 F.2d 1570, 225
11 USPQ 236 (Fed. Cir. 1985). By ignoring the present application's use of the claims limitations
12 as discussed in the Detailed Description, the argument as set forth in the Action ignores this
13 requirement. Understanding or interpreting a limitation *already in a claim* in light of the Detailed
14 Description is not the same as an impermissible reading of a limitation into a claim. Otherwise,
15 these court decisions are rendered meaningless. This need for consideration of "specification
16 language" is particularly applicable in computer process cases where terms carry a special
17 rather than ordinary (dictionary) meaning. Makino's access to RAM addresses (see e.g.,
18 Abstract) in the "Computer 2" do not qualify as such sites. Far from it, because of the goal of
19 grading test scores, the forms of the test and grading sheet seem to have to match for the
20 Makino system and method to work. Col. 4, ll. 7-26, 53-57. The only off-computer link is shown
21 in Makino's FIG 18 as a lightening bolt symbol "Communication Link;" this is explained in Col.
22 10 as simply "...the CPU 10 controls the storage of a program or data transmitted via a
23 communication link or the like from other device, in the storage medium 40, or the use of a
24 program or data stored in a storage medium provided in some other device, via a
25 communication link or the like." This known manner download function is not equivalent nor
26 related to applicant's annotation of an Internet site address itself, set forth in applicant's Claim 1
27 as "...a shift to said data address associated with the marked location." i.e., the computer
28 accessing a new Internet site itself.

29
30 A valid rejection on the ground of anticipation requires the disclosure in a single prior art
31 reference of each element of the claim under consideration. Soundscriber Corp. v. U.S., 148

1 USPQ 298, 301 (1966); In re Donohue, 226 USPQ 619, 621 (Fed. Cir. 1985). Makino does not
2 meet this requirement. It is respectfully requested that the rejections under Para. 1- 2 of the
3 Action be withdrawn.

4
5 RESPONSE TO REJECTION UNDER ACTION PARA. 3: SEC. 102
6

7 Claims 15 independent and 16 dependent thereon are rejected under U.S. Pat. No. 6,057,845
8 (Dupouy). Generally, Dupouy discusses a "System, Method, and Apparatus for Generation and
9 Recognizing Universal Commands." The functions and goal of Dupouy is simply to provide a
10 means for generating computer function recognition symbols which the user can design for use
11 with a plurality and variety of application programs. As with Makino, this has nothing to do with
12 Internet site access. The amendment of Claim 15 and cancellation of Claim 16 is set forth
13 herein. Again, it is respectfully requested that the rejections under Para. 1- 2 of the Action be
14 withdrawn.

15
16 More specifically, with respect to claim 15, the analysis which simply adds a citation to
17 applicant's claim is flawed. In fact, a user of Dupouy's system defines some arbitrary gesture
18 and associates it with a command, say "Open File", for a particular context, say Microsoft
19 Word. Then, at a later time, the user of Dupouy's system may invoke Word's "open file"
20 command by simply performing that gesture. However, the name of a particular file instance to
21 be opened, such as "C:\mydatadir\myfile.doc", would NOT be part of this universal command
22 definition. It would be impractical for a user of Dupouy's system to "hardwire" an individual file
23 name within a command definition. Rather the desired file name would have to be provided by
24 the user at the time that the "open file" gesture was performed. Dupouy's gesture-driven
25 commands are used in a "generic" fashion - that is, just a basic operation without arguments.
26 As a result, it would be difficult, if not impossible, for Dupouy's system to implement a temporary
27 bookmarking capability for a web-browser in the manner proposed by Lemon because each of
28 the URLs would need to be specified as a separate command even though the same browser
29 operation "Open Page" was involved. Dupouy's system associates gestures with COMMANDS
30 using definitions similar to hotkey definitions. Lemon's system, on the other hand, associates
31 mnemonic markings with OBJECT (or RESOURCE) references. Again, using an analogy: it is

1 like the difference between being able to dial a phone (Dupouy's COMMAND) and knowing the
2 phone number (Lemon's RESOURCE).

3
4 At Page 3 of the Action, penultimate line: "Claim 16 is also anticipated by Dupony {sic, Dupouy}
5 " Again there is an important distinction. Lemon's Claims 4 and 16 give examples of
6 possible types of RESOURCES - that is, OBJECTS rather than COMMANDS that might be
7 indexed by a mark on the tablet - for example: spreadsheet cells, mail messages, MP3 songs.
8 Each of these references would involve a specific instance such as "cell B14", "message 7329"
9 or "Blue Suede Shoes." This notion of everything having a uniform address is a relatively
10 recent concept in computer science and it would not necessarily be obvious re Dupouy -
11 especially in that Dupouy was concentrating on an invention for adapting gesture recognition to
12 COMMAND-DRIVEN interfaces of existing software. By contrast Lemon associates arbitrary
13 marks with EPHEMERAL Internet addresses - that is, addresses whose temporary nature
14 make it impractical, or even impossible, to index them with conventional browser bookmarking.
15

16 REJECTIONS UNDER SEC. 103

17
18 At Page 4 of Office Action, PARA. 5 it states: "Claims 7 and 10 are rejected ... over the
19 combination of Makino ... and Flurry." It has been shown that Makino does not stand for the
20 propositions asserted. Therefore, combinations therewith must fail. Claims 7 and 10 were
21 rejected as obvious under the combination of Makino with U.S. Pat. No. 4,633,436 (Flurry).
22 Claims 7 and 10 are dependent claims. The claims from which they depend, viz. Claims 5 and
23 9 (dependent from independent Claim 8) have been shown above to be allowable over Makino.
24 This rejection is therefore also rendered moot. It is respectfully requested that the rejections
25 under Para. 4-5 of the Action be withdrawn.
26

27 At Page 4, PARA. 6: "Claims 11, 12 and 14 are rejected ... as unpatentable over Dupony. In
28 reference to claim 11, Dupony discloses a computerized method...." Claims 11 (independent)
29 and 12 dependent therefrom, and Claims 17 (independent) and 18 dependent therefrom are
30 rejected as obvious in view of Dupouy. Claim 11 is to "accessing an internet site: and
31 associating an address of the site with a writable-erasable mnemonic device in a computer

1 writing tablet." Applicant finds nothing in Dupouy, discussed below in more detail, related to
2 Internet browsing, web computing or the like. There is no disclosure, suggestion, motivation,
3 nor in fact any such computer use discussed in Dupouy and this is acknowledge by the Action
4 on Page 5, starting about lines 3. The Action reaches a conclusory judgement when it states:
5 ". . .but his universal symbolic generator accounts for such a case because Dupouy says "the
6 user can customize the same input so that it will initiate different, but fully definable actions"
7 (column 2, lines 24-26). This is a clear suggestion that a user can use whatever function as
8 desired. Designating an Internet address is a common computing and Internet function."
9 Dupouy has systematically discussed computer convention applications and their functions.
10 Col. 4 starting at line 4 specifically calls out Word, WordPerfect, Corel Draw, and Lotus 1-2-3
11 and operations "such as cut, paste, copy, draw, etc." There is nowhere within Dupouy found
12 any reference to Internet browser programs which, if they had entered his mind, could have
13 been so listed and discussed. This "suggestion" that Dupouy had the Internet in mind comes
14 from the Office Action, not from any language found in Dupouy. It is respectfully requested that
15 the rejection be withdrawn.

16
17 With regard to details, technically speaking, the Action's analysis is also a misapplication.
18 Lemon's DELETE operation would simply have to touch the tablet within the bounding box
19 threshold to indicate a deletion request. In addition, due to the ephemeral nature of
20 Internet-based data, Lemon's delete command is likely to not be necessary in ordinary usage
21 but it is described for completeness as part of an alternate embodiment.

22
23 Moreover, it is not obvious because the information being erased is quite different. Makino uses
24 STROKE RECOGNITION to determine what marks have been placed in the various
25 predetermined boxes on a form. As Makino's stylus moves across the tablet a series of discrete
26 samples are taken which represent the path of the stylus. Flurry's invention would provide a
27 way to "erase" Makino's strokes in an efficient manner. However, as described previously,
28 Lemon's system DOES NOT need to RECOGNIZE or INTERPRET the marked symbols.
29 Lemon's invention only needs to compute the LOCATION (the bounding box within some
30 THRESHOLD) which contains the mark. Lemon's method NEVER stores this stroke information

1 and subsequently never needs to DELETE stroke information. As a result, Flurry's invention
2 would be useless and irrelevant to Lemon.

3
4 At Page 5, line 3, the Action continues, "Dupony never specifically states that the method be
5 used while accessing an Internet site but his universal symbolic generator accounts for such a
6 case ..." This is incorrect. Dupouy's generator does not account for such a case because
7 Dupouy's approach cannot ADD functionality to an application but rather it can only provide
8 customized shortcuts to existing commands via a gesture-based interface. Dupouy's gestures
9 are linked to commands. The purpose of Dupouy's invention is to provide a gesture-based
10 interface to existing software applications (each of which may have its own idiosyncratic
11 commands). This is analogous to a so-called "universal remote control" that one might
12 purchase for use at home as an "interface" to a collection of audio/video devices (such as TV,
13 stereo, VCR and DVD players). Such a controller provides a way to consolidate the control of
14 the separate devices into a single controller. As a result, for example, the "fast forward" button
15 on the universal control can perform a "fast forward" operation on either the VCR or DVD player
16 even though, in reality, each of these devices may have a different command sequence for their
17 "fast forward" operations. However, taking this analogy further, such a universal remote control
18 CANNOT add FUNCTIONALITY that is NOT ALREADY PRESENT within the devices being
19 controlled. Like Dupouy's system, the universal remote control in our analogy only provides
20 SHORT-CUTS to existing commands. For example, if one's VCR does not have a "slow
21 motion" capability, no amount of configuring the universal control will add a "slow motion"
22 capability. In similar fashion, Dupouy's system only associates gestures with EXISTING
23 commands. Since current web browsers do not support a convenient facility (see Lemon, Page
24 2, Paragraph 4) for booking temporary links, Dupouy's system cannot account for this case
25 because there are no appropriate browser commands to which gestures could be linked.

26
27 The Action at Page 5, about line 10: "Referring to claim 12, the method also includes table
28 function keys associated with writing-erasing a mnemonic device ..." As noted previously
29 Lemon's delete capability is optional. A dependent claim includes all the limitations of the claim
30 from which it depends and, as such, makes specific that which was general. 35 USC 112; 37
31 C.F.R. Sec. 1.75c); Allen Group, Inc. V. Nu-Star, Inc., 197 USPQ 849 (7th Cir. 1978); Ex parte

1 Hansen, 99 USPQ 319 (Pat. Off. Bd. App. 1953). Dependent claims are non-obvious if the
2 independent claims from which they depend are non-obvious. In re Fine, 5 USPQ2d 1596,
3 1600 (Fed. Cir. 1988); see also Hartness International, Inc. V. Simplimatic Engineering Co., 2
4 USPQ2d 1826, 1831 (Fed. Cir. (1987) to the same effect re novelty). Thus, allowance of a base
5 claim as patentable normally results in allowance of a claim dependent upon that claim.

6
7 The Action at Page 5, about line 13: "Referring to claim 14, the method also automatically
8 alternating accesses between a plurality of addresses ..." The same argument is proffered in
9 the discussion of COMMAND versus RESOURCE above.

10
11 The Action at Page 5, about line 17: "Claims 17 and 18 are rejected on the same grounds as
12 claims 11 and 12." See above comments on claims 11 and 12.

13
14 The Action at Page 5, about line 18: "Claim 20 is rejected on the same grounds as Claim 14."
15 See above comments on claim 14.

16
17 The Action at Page 5, PARA. 7: "Claim 13 is rejected ... as being unpatentable over the
18 combination of Dupony and Makino." Again, the above discussion above on difference between
19 COMMANDS and OBJECTS is applicable. Dupouy needs to link his gestures to COMMANDS.
20 Trying to associate gestures to OBJECTS is not semantically meaningful. It would not be
21 obvious for the same reasons as stated above.

22
23 At Page 6 of the Action, about line 6: "Claim 19 is rejected on the same grounds as claims 13"
24 See above comments on claim 13.

25 26 SUMMARY AND CONCLUSION

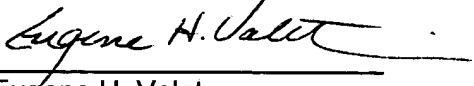
27
28 Applicant has shown specific technical differences above which eliminate all the references
29 cited. Moreover, legal reasons for rejection of each of the applications of the references has
30 been raised. Therefore, all grounds for rejection have been overcome.

1 Based upon the foregoing, it is submitted that the application now presents claims which are
2 directed to novel, unobvious and distinct features of the present invention which are an
3 advancement to the state of the art. Reconsideration and early allowance of all claims is
4 respectfully requested. The right is expressly reserved to reassert any and all arguments,
5 including the raising of new arguments, should a Notice of Allowance not be forthcoming.
6 Applicant reserves the right to reinsert claims and to prosecute claims via continuing and
7 divisional applications.

8
9 Questions or suggestions that will advance the case to allowance may be directed to the
10 undersigned by teleconference at the Examiner's convenience.

11
12 Date: JUNE 19, 2003

Respectfully submitted,
Hewlett-Packard Company

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